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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,040	03/28/2006	Toshirou Ariga	09852/0204249-US0	8937

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EXAMINER	
JOY, DAVID J	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
09/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,040	ARIGA ET AL.	
	Examiner	Art Unit	
	David J. Joy	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 are pending as amended on June 26, 2008.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendments

3. Applicant's replacement abstract, filed June 26, 2008, in order to correct a grammatical error, has been fully considered and is corrective. As such, the objection to the abstract of the disclosure has been withdrawn.

4. Applicant's amendment to Claim 1, filed June 26, 2008, obviates the previously cited objection to the claim. Therefore, the objection of Claim 1 has been withdrawn. (Likewise, the amendments made to Claim 2-6, to correct minor grammatical errors, have been fully considered and are proper.)

Claim Rejections - 35 USC § 102

5. Claims 1-7 stand rejected under 35 U.S.C. 102(a) as being anticipated by the International Application Publication of Ariga et al. (WO 2004/002752 A1; hereinafter "Ariga"). For the purposes of this Office Action, all citations will be made to the European Patent Application of Ariga et al. (EP 1 552 961 A1) as an English equivalent of the International Application Publication.

6. Ariga teaches a hydraulic transfer film having a supporting film ("substrate film") made of a water-soluble or water-swellable resin, and a transfer layer that is soluble in organic solvent positioned on top of the supporting film (see Abstract; see also ¶¶ [0010] and [0013]). Ariga also teaches that the transfer film has a release film ("peelable film") that is on top of the transfer layer at an interface with the transfer layer (see Abstract; see also ¶¶ [0010], [0063] and [0064]). With regard to the transfer layer, Ariga recites that the transfer layer includes a curable resin layer that is curable by irradiation with an active energy beam and a decorative layer that contains an ink or a coating film (see Abstract; see also ¶¶ [0010], [0016], [0057] and [0058]). Additionally, the curable resin layer is non-adhesive at room temperature, and the layer contains a non-polymerizable thermoplastic resin ("thermoplastic resin") and a radical polymerizable oligomer ("radiation-curable resin") that is compatible with the

thermoplastic resin (see ¶¶ [0018], [0019]). Further, Ariga teaches that the radiation-curable resin can be an epoxy acrylate, polyester acrylate, or a urethane acrylate, and that the resin has a mass average molecular weight of 300 to 10,000 (see ¶¶ [0025] – [0026]). As for the thermoplastic resin, Ariga teaches that the resin is compatible with the radiation-curable resin and that the resin can be an acrylic resin or a polyester resin, and that the resin has a mass-average molecular weight from 3,000 to 400,000 (see ¶¶ [0038]-[0042]). Though Ariga recites that the molecular weights are mass-average molecular weights, the measurements are anticipatory of the ranges that are claimed for the weight-average molecular weights of the claimed resin components.

7. Ariga teaches that the thermoplastic resin is added in the amount of less than 70 parts by weight based on the total weight of the resin in the curable resin (see ¶ [0038]). Therefore, as Ariga provides that the thermoplastic resin and the radiation-curable resin are both present in the curable resin layer, it follows that the combined weight of the two resin components can be such that they account for at least 60% by weight of the curable resin layer. Ariga also teaches that in addition to the thermoplastic resin and the radiation-curable resin, the curable resin layer can also contain a polymerizable compound ("thermosetting resin") (see ¶ [0018]). Ariga further teaches that thermosetting resin can be such that it is of the same type of resin as the radiation-

curable resin, which includes a resin having a mass average molecular weight of 300 to 10,000, which includes the limitation that the compound has a molecular weight of at least 200 but less than 700 (see ¶ [0044]). Finally, Ariga teaches that the transfer film can be used to produce a hydraulically transferred body with a cured resin layer (see ¶ [0079]).

Response to Arguments

8. Applicant's arguments filed June 26, 2008 have been fully considered but they are not persuasive.

9. Applicant states that Ariga is applicable as a reference under 35 U.S.C. §102(a) since the present application was filed in the international stage on September 30, 2004, while Ariga was published on January 8, 2004. Also, Applicant states that the present application claims priority through the PCT application to Japanese Patent Application No. 2003-340351 (hereinafter "JP-351"), which was filed on September 30, 2003. In addition, Applicant asserts that the priority date of the present application pre-dates the publication date of Ariga, and that the certified, literal English translation of the Japanese priority document (hereinafter "JP-351" as well), that was submitted as

Exhibit A with the amendment filed June 26, 2008, perfects that claim of priority. However, Examiner disagrees with that assertion.

10. The certified literal English translation of JP 2003-340351 fails to perfect the claim of foreign priority. In particular, JP-351 fails to provide adequate support for all of the limitations that appear in Claim 1 of the present application. The limitation that the decorative layer "*contacts* a transfer target body *directly* during hydraulic transfer" is not supported by the teachings of JP-351. In addition, nowhere in JP-351 is it taught that the thermoplastic resin is *non-polymerizable*. Also, the limitations that *the acrylic resins having a weight-average molecular weight within a range from 70,000 to 250,000 and polyester resins having a weight-average molecular weight within a range from 30,000 to 70,000* is not supported by JP-351. Further, the limitation that the film for hydraulic transfer has *a release film on top of said transfer layer at an interface with said transfer layer*, as recited in Claim 6, is not supported by the teachings of JP-351. Consequently, the claim of foreign priority under 35 U.S.C. §119(a)-(d) is not perfected. Therefore, Ariga is still applicable as a reference under 35 U.S.C. §102(a), and the rejection of the present claims as being anticipated by Ariga stands.

11. Applicant separately argues that Ariga claims priority to Japanese Patent Application No. 2002-191992 ("JP-992"), which was published February 5, 2004, but that through the claim of foreign priority to Japanese Patent Application No. 2003-340351, the priority date of the present application pre-dates the publication date of JP-992, so JP-992 is not prior art to the present application. However, as discussed hereinabove, since the claim of priority to JP-351 is not perfected and is, therefore, no longer valid, JP-992 would still be a valid reference.

12. Finally, Applicant argues that the European counterpart of Ariga published July 13, 2005 (EP 1 552 961) is not prior art to this application. However, the rejection of the present claims was made over Ariga, while the European counterpart was treated as an English language equivalent of that which appears in the text of Ariga, and the citations to the teachings in English were made for reference purposes only.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/
Examiner, Art Unit 1794
09/16/2008

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794